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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,856	08/02/2001	Gregory P. Fitzpatrick	BOC9-2000-0082(217)	7129

7590 10/28/2003

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EXAMINER
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ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 10/28/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,856

Applicant(s)

FITZPATRICK ET AL.

Examiner

Neveen Abel-Jalil

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2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 6
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The declaration filed on July 22, 2003 has been received and entered. The priority date of November 10, 2000 hereby considered. Claims 1-17 are pending.

#### *Response to Amendment*

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolnick et al. (U.S. Pub. No. 2002/0023230 A1) in view of Harari (U.S. Pub. No. 2002/0016857 A1).

As to claims 1, and 12, Bolnick et al. discloses a method for generating a list of contacts (See page 7, paragraphs 0115-0118), a machine readable storage having stored thereon a computer program for generating a list of contacts (See page 2, paragraph 0025), said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps comprising the steps of:

first retrieving a plurality of contacts from an exposed, remotely accessible contact list  
(See pages 2-3, paragraphs 0026-0027),

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list (See page 8, paragraphs 0162-0167, wherein "comparator" reads on "out-of-date");

second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts; second comparing said second retrieved contacts to said locally stored contacts (See page 8, paragraphs 0167-0171, also see abstract, and see page 5, paragraphs 0068-0070).

Bolnick et al. does not disclose first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and,

storing said identified common contacts in a list of common contacts.

Harari discloses first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include first identifying common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include first identifying

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common contacts among said first compared contacts; second identifying common contacts among said second compared contacts; and, storing said identified common contacts in a list of common contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claims 2, and 13, Bolnick et al. as modified discloses further comprising the step of repeating said second retrieving, second comparing and second identifying steps for each first retrieved contact not identified as a common contact in said first identifying step (See page 4, paragraph 0065, wherein “not identified” reads on “determination of shared access”, also see page 4, paragraph 0067, also see pages 5-6, paragraphs 0086-0087).

As to claims 3, and 14, Bolnick et al. as modified discloses wherein said second retrieving step comprises the step of second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts not identified as a common contact in said first identifying step (See page 6, paragraph 0108, wherein “not identified as common contact” reads on “can be integrated into member’s display list”).

As to claims 4, and 15, Bolnick et al. discloses a method generating a list of common contacts (See page 7, paragraphs 0115-0118), a machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps, said steps comprising:

exchanging contact lists over a physical communications link (See page, wherein “exchanging” reads on “sharing”);

Bolnick et al. does not disclose comparing contacts in said exchanged contact lists to identify matching contacts; and,

storing said matched contacts in a common contact list.

Harari discloses comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include comparing contacts in said exchanged contact lists to identify matching contacts; and, storing said matched contacts in a common contact list because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claims 5, and 16, Bolnick et al. discloses wherein said exchanging step comprises the steps of: establishing a wireless communications link; and, exchanging said contact lists over said established wireless communications link (See page 8, paragraph 0167, wherein “exchanging” reads on “sharing”)

As to claims 6, and 17, Bolnick et al. discloses a method of generating a list of common contacts (See page 7, paragraphs 0115-0118), A machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps (See page 2, paragraph 0025), said steps comprising:

accessing a contact list in a remotely accessible database of contacts (See page 4, paragraphs 0063-0065, also see page 6, paragraph 0108);

providing a visual hyperlink for each matching contact produced by said comparing step (See page 1, paragraph 0013, also see page 8, paragraphs 0167-069).

Bolnick et al. does not disclose comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts.

Harari discloses comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include comparing contacts in said contact list with contacts in a stored database of contacts, said comparison producing matching contacts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include comparing contacts in said contact list with contacts in a stored database of contacts, said comparison

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producing matching contacts because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claim 7, Bolnick et al. discloses a common contact identification system (See page 7, paragraphs 0115-0118) comprising:

at least two contact lists, each said contact list comprising a plurality of contacts, each said contact list having a publicly accessible interface through which said contacts can be accessed remotely (See page 2, paragraphs 0018, also see pages 2-3, paragraphs 0025-0027, wherein "publicly accessible" reads on "Internet", also see page 4, paragraph 0065, wherein "contact lists" reads on "address book", also see page 3, paragraphs 0034-0036, wherein "accessed remotely" reads on "Instant Messenger");

a comparator for comparing contacts in each of said at least two contact lists, said comparator identifying matching contacts in each of said at least two contact lists (See figure 7, shows two PDA's indicating two contact lists, also see page 10, paragraphs 0238-0239, also see page 9, paragraph 0202, and see page 8, paragraphs 0167-0169).

Bolnick et al. does not disclose a common contact list comprising contacts matched by said comparator.

Harari discloses a common contact list comprising contacts matched by said comparator (See page 3, paragraphs 0031-0033, also see page 5, paragraphs 0043-0046).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. to include a common contact list comprising contacts matched by said comparator.



It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolnick et al. by the teaching of Harari to include a common contact list comprising contacts matched by said comparator because it provides for efficient database organization and access thereby reducing processing time and business expenses.

As to claim 8, Bolnick et al. as modified discloses wherein each said contact list is stored in a storage medium selected from the group consisting of a database (See page 3, paragraph 0032), a contact management program data store (See page 2, paragraph 0014), an e-mail program address book, an instant messenger address book, a cellular phone address book, and a personal digital assistant address book (See page 10, paragraphs 0227-0231, wherein "cellular phone" reads on "wireless").

As to claim 9, Bolnick et al. as modified discloses further comprising a communications link between said contact lists over which said contacts in said contact lists can be transmitted (See pages 2-3, paragraphs 0026-0027, wherein "communication link" reads on "Internet").

As to claim 10, Bolnick et al. as modified discloses wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link (See Harari page 1, paragraph 0017).

As to claim 11, Bolnick et al. as modified discloses wherein said common contact list comprises at least one hyperlinked address of a matched contact (See page 1, paragraph 0013, also see page 8, paragraphs 0167-069).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Balsara et al. (U.S. Patent No. 6,065,012) teaches method for displaying and manipulating user-relevant data.

Smiga et al. (U.S. Pub. No. 2003/0167279 A1) teaches method for group action processing between users of a collaboration system.

McDowell et al. (U.S. Pub. No. 2001/0034224 A1) teaches method for sharing mobile user event information between wireless and fixed IP networks.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 703-305-8114. The examiner can normally be reached on 8:00AM-4: 30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Neveen Abel-Jalil  
October 1, 2003

DIANE D. IZZAH  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100